RESTRICTION ELECTION FACSIMILE TRANSMISSION

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FROM/ATTORNEY: Mary M. Krinsky

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TO EXAMINER: Josephine Young

ART UNIT: 1623

SERIAL NUMBER: 09/868/348

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PLEASE NOTE: THIS FACSIMILE NUMBER IS TO BE USED ONLY FOR RESPONSES TO RESTRICTIONS.

COMMENTS: _____

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	Barry V.L. Potter, *et al.*
Serial No. - 09/868,348	Filing Date: June 15, 2001
Art Unit: 1623	Examiner: Josephine Young
Invention Title	Cyclic Adenosine Diphosphate Ribose Analogues for Modulating T Cell Activity

Commissioner of Patents
and Trademarks
Washington, DC 20231

Reply to a Restriction Requirement Under PCT Rule 13.1 and 35 U.S.C. §§ 121 and 372

Dear Sir:

Please consider the remarks that follow, sent in response to a Restriction Requirement dated 30 October 2002.

REMARKS

Claims 1 to 5, 8, 15, and 23 to 31 are pending in this application, which relates primarily to compounds such as cyclic adenosine diphosphate ribose analogues capable of antagonizing a sustained cADPR-mediated rise in intracellular Ca^{+2} levels in a T cell in response to stimulation of the T cell receptor/CD3 complex of the T cell, methods of identifying these, and their use in modulating T cell activity.

In the above-referenced communication from the Patent Office, the Examiner required restriction between what were perceived as the following three groups of inventions:

I hereby certify that this correspondence is today being facsimile transmitted to the U.S. Patent Office's restriction election facsimile number for the art unit, 703-308-4315, on the date shown below.

December 2, 2002

Mary M. Krinsky

Group I (claims 1 to 5, 8, 19 to 22, and 23 to 28), drawn to methods for modulating T cell activation *in vivo* or *ex vivo* by modulating a sustained rise in Ca^{+2} entry via a cADPR-mediated pathway, and for treating related diseases;

Group II (claims 29 to 31), drawn to methods for identifying a substance capable of modulating a sustained rise in Ca^{+2} entry via a cADPR-mediated pathway; and

Group III (claim 15), drawn to compounds identified using the assay of Group II.

Applicants elect with traverse group I directed to methods of modulating T cell activation. The requirement is traversed because Applicants do not agree with the Examiner's assessment that the claims "do not relate to a single general inventive concept under PCT Rule 13.1" as set out in the Office Action. All three groups exhibit a unity of invention under PCT Rule 13.2 because there is a technical relationship among the claimed inventions, as they all recite the same functional properties related to T cell activation. The Office Action asserts that all the groups "have no common special technical feature", citing, for example, WO 98/43992 to Galione, *et al.*, published 8 October 1998. This appears to be a rejection on the merits rather than support for a restriction requirement. Applicants believe they have made a contribution over the prior art for the invention as a whole, directed to cyclic adenosine diphosphate ribose analogues and the like compounds that exhibit unique functional properties set out in the claims.

Thus, the claims have "a community of properties justifying their grouping which [is] not repugnant to principles of scientific classification" under U.S. restriction practice [*In re Harnish*, 631 F.2d 716, 206 U.S.P.Q. 300, 305, (C.C.P.A. 1980)], and are "so linked as to form a single general inventive concept" as set down in PCT Rules 13.2, 13.3, and 13.4. In general, in the U.S. an Applicant has a "right to define what he regards as his invention as he chooses, so long as his definition is distinct" [*ibid.*]. That court and its successors have long recognized the advantages to the public interest in permitting Applicants to claim all aspects of the invention so as to encourage the making of a more detailed disclosure of all aspects of their discovery. The inventions are not "separate and distinct" as required by 37 C.F.R. § 1.141 (a).

> We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. § 112, all aspects of what they regard as their inventions, regardless of the number of statutory classes involved.
>
> *In re Kuehl*, 177 U.S.P.Q. 250, 256 (C.C.P.A. 1973).

A search of compounds exhibiting unique T cell activating properties set out in the Group I claims should lead to the references applicable to the other groups and should not be an undue burden for examination purposes. Moreover, requiring Applicants to pay filing fees, prosecution costs, issue fees, and maintenance fees for three patents for one invention directed to the use of similar compounds *is* an undue burden for Applicants, particularly as they are academic inventors having small entity status. For these reasons, Applicants respectfully request that the requirement for restriction be withdrawn.

If the undersigned can advance the prosecution of the application in any way, she is invited to call the undersigned at the number set out below.

Respectfully submitted,

December 2, 2002

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